

REMARKS

Claims 1 through 29 are in the application, with Claims 1, 13 and 24 being independent.

The pending claims are subject to a restriction requirement. In particular, the Office Action groups the claims into Claims 1 through 12 (Group I), Claims 13 through 23 (Group II), and Claims 24 through 29 (Group III). Election of one of these Groups is required because the Groups are alleged to be distinct.

In response to the restriction requirement, Applicants provisionally elect Group II, Claims 13 through 23. Examination and allowance of the elected claims are respectfully requested.

This provisional election is made with traverse. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 CFR §1.143. As grounds for traversal, Applicants believe that Groups I through III are clearly not distinct from one another.

Alleged distinctiveness between Group I and Group II

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. As described in MPEP §806.05(f), the test for determining distinctness of claims directed to a product (i.e., the Group II claims) and to a process for making the product (i.e., the Group I claims) includes two prongs, and the claims may be deemed distinct if either prong is satisfied. The Office Action uses Form Paragraph 8.18 to set forth the test for distinctness. According to the Form Paragraph, the first prong is “that the process as claimed can be used to make other and materially different product (sic)”. The claimed inventions were deemed to be distinct because they allegedly satisfied this first prong. In particular, the Office Action alleges “instead of using a no-flow underfill as required by the product, one could use a flowable underfill.”

However, after reviewing §806.05(f), Applicants note that the first prong of the test for distinctness is “**that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products (emphasis added)**”. Applicants submit that the claimed product and process do not satisfy the first prong of the test

for distinctness because the claimed process is an obvious process of making the claimed product.

The Office Action fails to establish distinctness even under the Office Action's erroneous interpretation of the first prong. Specifically, the alleged first prong requires a determination of whether "the process as claimed can be used to make other and materially different product (sic)" (emphasis added), but the example provided describes a process in which flowable underfill material is substituted for the no-flow underfill of the claimed process. The fact that the described materially-different process might be used to make a product materially different from that claimed in Group II does not prove that the claimed process can be used to make a product materially different from that claimed in Group II.

Alleged distinctiveness between Group II and Group III

The Office Action further alleges that the Group II claims are related to the Group III claims as apparatus and product made. Applicants submit that, under any interpretation of MPEP §806.05(g), the Group II claims and the Group III claims are not related as apparatus and product made. MPEP §806.05(g) is intended to describe a situation in which the claimed product may be made by the claimed apparatus. The Group II product and the Group III system clearly do not fit this description.

Rather, Group II and Group III represent a subcombination and a combination as described in MPEP §806.05(c)II. ("Subcombination Essential to Combination"). In this regard, the separately claimed subcombination of Group II "constitutes the essential distinguishing feature of the combination" of Group III. Restriction therefore "must not be made" (see §806.05(c)II) between Group II and Group III.

Alleged distinctiveness between Group II and Group II

The Office Action alleges that the Group I claims are related to the Group III claims as a process and an apparatus for its practice, and should therefore be evaluated under MPEP §806.05(e). However, §806.05(e) applies to situations in which the claimed apparatus may practice the claimed process. In contrast, the Group III system includes an element that may be fabricated by the Group I process. MPEP §806.05(e) is clearly not applicable to the relationship between the Group III claims and the Group I claims.

In summary, Group I is clearly not distinct from Group II or from Group III, and Group II is clearly not distinct from Group III. Restriction between these Groups is therefore believed to be improper.


CONCLUSION

In view of the foregoing, Applicants respectfully request withdrawal of the outstanding restriction requirement and examination of Claims 1 through 29 on the merits. In this regard, Claims 1 through 29 are believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

If there remains any question regarding the present application, or if the Examiner has any suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned via telephone at (203) 972-0049.

Respectfully submitted,

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Date



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